

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following comments and present amendments, is respectfully requested.

Claims 1 and 3-24 are pending. Claim 1 is amended to recite the features of now-canceled dependent Claim 2. Claim 2 is canceled without prejudice or disclaimer. Claims 3 and 5 are amended to update dependencies in light of the cancellation of dependent Claim 2. Claim 9 is placed in independent form in light of the indication of allowable subject matter. Claim 18 is amended to address an informality. Claim 22 is newly added. Support for newly added dependent Claim 22 can be found in original Claim 8, for example. Support for newly added Claims 23 and 24 can be found in Figs. 1a, 1b, and 2 and in the published specification in numbered paragraph [0052], for example. No new matter is added.

In the outstanding Office Action, the Restriction Requirement dated September 25, 2009, was withdrawn. Claims 7, 9, and 18 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claim 1 was rejected under 35 U.S.C. § 102(b) as anticipated by Takehana (Japanese Patent No. JP 10117836). Claims 1, 13, 16, and 17 were rejected under 35 U.S.C. § 102(b) as anticipated by German Patent No. 1911176, herein "DE '176." Claim 1 was rejected under 35 U.S.C. § 102(b) as anticipated by Aldworth (British Patent No. GB 207,948). Claims 2-4 were rejected under 35 U.S.C. § 103(a) as obvious over Takehana in view of DE '176. Claim 5 was rejected under 35 U.S.C. § 103(a) as obvious over Takehana in view of DE '176 and Kobayashi (PCT Application No. WO 03/007752, herein "Kobayashi"). Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as obvious over Takehana in view of Wajaroff (U.S. Patent No. 4,470,423, herein "Wajaroff"). Claims 14, 15, 20, and 21 were rejected under 35 U.S.C. § 103(a) as obvious DE '176 in view of Takehana. Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as obvious over Aldworth in view of Wajaroff. Claims 10 and 19 were rejected under 35 U.S.C. § 103(a) as obvious

over Aldworth in view of Wajaroff and Takehana. Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as obvious over Aldworth, Wajaroff, Takehana, and Sturdivant (U.S. Patent No. 3,255,765, herein "Sturdivant"). Claims 9 and 18 were indicated as reciting allowable subject matter.

Applicants note with appreciation the indication that Claims 9 and 18 recite allowable subject matter.

Applicants further note with appreciation the courtesy of a personal meeting granted by Primary Examiner Robyn Doan on March 2, 2010.

Additionally, as summarized below in accordance with MPEP § 713.04, Applicants' representative contacted Examiner Doan on March 26, 2010, to request the English translation of DE '176 discussed in the interview summary provided by Examiner Doan. Examiner Doan emailed the English translation on March 26. Applicants' representative indicated that, under MPEP § 710.06, the time period for responding to the outstanding Office Action should be lengthened to account for the time between the March 2, 2010, meeting (when Examiner Doan indicated that she would send the above-noted translation) and March 26, 2010. Examiner Doan indicated that she would not lengthen the time period for filing a response inasmuch as DE '176 was cited earlier by Applicants in an IDS.

In combination with the interview summary provided by Examiner Doan, the substance of the personal meeting is substantially summarized below in accordance with MPEP § 713.04.

Regarding the rejection of Claim 7 as indefinite for not reciting a temperature at which a viscosity is recited, Applicants respectfully note that **i)** viscosity is not necessarily variable with temperature, and **ii)** the mere fact that all of the conditions surrounding a recited value such as viscosity are not themselves recited in a claim does not render that claim

indefinite. Rather, as discussed during the personal interview, **breadth of a claim is not the same as indefiniteness.**

MPEP § 2173 states:

2173.04 Breadth Is Not Indefiniteness

Breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Claim 7 recites a hair treating agent having a viscosity of 100 mPa·s or higher. No temperature at which the above-noted viscosity occurs is specified. Therefore, the claim is broad in this respect. However, breadth of a claim is not indefiniteness, and the breadth of Claim 7 does not render this claim indefinite.

Accordingly, Applicants respectfully submit that a person of ordinary skill in the art would understand the features recited in Claim 7 without the recitation of a temperature at which the viscosity recited in Claim 7 is measured. Thus, Applicants respectfully submit that the rejection of Claim 7 as indefinite should be withdrawn.

Regarding the rejection of Claims 9 and 18 as indefinite for reciting a "flat tube," Applicants respectfully traverse this rejection as follows. Applicants respectfully note that Claims 9 and 18, before the present amendment, recited "a flat tube" rather than merely "flat tube" as set forth on page 2 of the outstanding Office Action. In other words, as the flat tube in the claim dependency tree for Claims 9 and 18 is first recited in Claims 9 and 18, the indefinite article "a" was placed in front of the words "flat tube." Accordingly, Applicants respectfully submit that the "flat tube" recited in Claims 9 and 18 was properly set forth under U.S. practice. However, in order to advance prosecution, Claims 9 and 18 are amended to further clarify that the flat tube further defines the hair holder. Accordingly, Applicants

respectfully submit that amended independent Claims 9 and 18 are not indefinite, and the rejection of Claims 9 and 18 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

Regarding the rejection of Claim 1 as anticipated by each of Takehana, DE '176, and Aldworth, Claim 1 is amended to recite all of the features of now-canceled dependent Claim 2. Accordingly, Applicants respectfully submit that the rejections of Claim 1 as anticipated by each of the three references noted above is overcome.

As amended independent Claim 1 recites the features of now-canceled dependent Claim 2, Applicants address the rejection of Claim 2 in relation to amended independent Claim 1. In this regard, amended independent Claim 1 recites, in part:

wherein at least one of the hair holding sheets is **an agent-impregnated sheet having a Taber stiffness of 0.2 mN·m or higher** and a water retention of 0.03 g/cm² or more and impregnated with the hair treating agent.

Thus, Claim 1 recites an **agent-impregnated sheet**. The agent impregnated sheet has a **Taber stiffness of 0.2 mN·m or higher**. As discussed in the specification, "The sheet constituting the hair holding sheet preferably has a Taber stiffness of 0.2 to 20 mNm. With the Taber stiffness being in that range, leakage of the hair treating agent is prevented even when the hair holding sheet is rolled up, and the hair holding sheet has improved rolling operability and improved capability of holding a hair bundle in shape."¹

On page 4, the outstanding Office Action acknowledges that Takehana fails to disclose a water retention and Taber stiffness of 0.2 mN·m. The outstanding Office Action relies on DE '176 for the above-noted features. During the personal interview, Examiner Doan indicated that DE '176 discloses the above-noted stiffness. However, Applicants respectfully note that DE '176 does not disclose the above-noted Taber stiffness recited in amended independent Claim 1. Nor has the outstanding Office Action attempted to cite to a

¹ Published application, numbered paragraph [0018].

specific section of DE '176 disclosing the recited stiffness or even discussing this variable.² Applicants further note that DE '176 the English translation provided by Examiner Doan is silent regarding a Taber stiffness. Accordingly, an assertion that DE '176 discloses a particular result-effective variable is not supported by the record in accordance with 37 C.F.R. § 1.104. Accordingly, Applicants respectfully submit that the rejection of Claim 2 (and therefore amended independent Claim 1) should be withdrawn.

Additionally, a person of ordinary skill in the art would not have had any apparent reason to modify Takehana to include the specific Taber stiffness recited in amended Claims 1 and 6 inasmuch as Takehana is intended to be kept in a **straight** position. This is so because Takehana is merely used to "partially and beautifully dye hair for oneself."³ To perform this process, the device described in Takehana is not rolled up. Therefore, the stiffness of the device is irrelevant to any specific result intended by Takehana. Accordingly, a person of ordinary skill in the art would have had no apparent reason, at the time the inventions recited in Claims 1 and 6 were made, to modify sheet (4) of Takehana to have any particular stiffness, much less the stiffness recited in Claims 1 and 6.

Furthermore, the English translation of DE '176 provided by Examiner Doan states that the base plate provided is to be "flexible." English translation of DE '176 is unconcerned with providing any **minimum** stiffness. Rather, to the extent the English translation of DE '176 comments on this property, the translation indicates that the opposite property, i.e., flexibility, be provided.

None of the remaining references discloses the above-noted Taber stiffness number recited in amended independent Claim 1 and also recited in independent Claim 6.

² Furthermore, only result-effective variables can be optimized. MPEP § 2144.05(ii)(B) states: A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

³ Takehana, English Abstract.

Accordingly, Applicants respectfully submit that amended independent Claim 1 and the claims depending therefrom along with independent Claim 6 and the claims depending therefrom patentably distinguish over any reasonable combination of the cited references for at least the reasons discussed above.

Consequently, in light of the present amendment and discussion above, the present application is believed to be in condition for allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Richard L. Chinn, Ph.D.
Registration No. 34,305

Lee L. Stepina
Registration No. 56,837
Attorneys of Record

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/09)